

REMARKS

Claims 2, 5-7, 9, 10, 13, 15, 16, 19 and 21-26 are presently pending in this application. By this Amendment claims 7, 19, 21-23 have been amended, no claims have been canceled and no new claims have been added.

I. Claim Rejections Under 35 U.S.C. § 112

The Examiner has rejected claims 7 and 22 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Pursuant to the claim rejections set forth by the Examiner, Applicants' have amended claims 7 and 22 to properly and clearly address the claimed subject matter. Specifically, the Applicants have amended claim 7 to recite "an active image of the first content associated with the annotation, wherein the first content changes over time.", and with regards to claim 22, Applicants have amended claim 22 to recite "between a first and second regions." Accordingly, the Applicants respectfully request the withdrawal of the claim rejections under 35 U.S.C. § 112 to claim 7 and 22. Applicants respectfully traverse these rejections.

II. Claim Rejections Under U.S.C. § 102 and § 103

The Examiner rejects claims 13 and 19 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,766,494 to Price et al. (hereinafter "Price"); and rejects claims 9, 10, 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Price and in further view of U.S. Patent No. 6,551,357 to Madduri (hereinafter "Madduri"); and rejects claims 5-7 and 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Price and in further view of U.S. Patent No. 5,592,568 to Wilcox et al. (hereinafter "Wilcox"); and rejects claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Price and Wilcox and in further view of U.S. Patent No. 6,279,014 to Schilit et al. (hereinafter "Schilit"); and rejects claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Price and Wilcox and in further view of Madduri. Applicants respectfully traverse these rejections.

Applicants submit that in dramatic contrast to claimed invention, none of the asserted references, either taken alone or in any reasonable combination, at least teach, disclose or suggest each and every element of the claimed invention. Specifically and with regard to independent claims 13 and 19, for example, Applicants respectfully assert that none of the asserted references, that is, as best understood, there is simply nothing in Price, Madduri, Wilcox, or Schilit that remotely suggests a method or system for receiving data comprising, *inter alia*, the data will include a user interface to allow various selections of an active content change when since the previous access session the active content has changed, and wherein selection of said annotation accesses the at least two documents to display said annotation based on the active content selection, as required by independent claim 13.

Instead, and with regards to Price, the system discussed by Price merely discusses free-form ink anchors and the generation of links between documents located in different windows. See, for example, Price, Abstract.

For at least these reasons, Applicants submit that Price fails to anticipate the claimed combination of elements as recited by amended claims 13 and 19. As such, amended independent claims 13 and 19 are clearly patentable over Price. Accordingly, the immediate withdrawal of the prior art rejection of claims 13 and 19 under section 102 to Price is respectfully requested.

With regards to the combination of Price in view of Madduri, and as applied to claims 9, 10, 15 and 16, Applicants respectfully submit that Madduri fails to provide what is lacking in Price to render obvious any of claims 9, 10, 15 and 16. Instead, Madduri appears to merely discuss a system for cataloging and marking separate data structures as they are associated with a window appearing within a graphical user interface. As such, Applicants respectfully assert that the Office Action fails to meet its burden under a prima facie case of obviousness with regards to section 103 and the attempted combination of Price in view of Madduri.

Furthermore, and for at least the reasons discussed above with regards to Price individually, and with regards to claim 15, the combination of Price in view of Madduri, fails to render obvious a computer-readable medium having a program stored thereon, comprising, *inter alia* associated content will include a user interface to allow various selections of an active

content change when since the previous renderable image upon the user interface, the active content associated with the annotation has changed and filtering said combination of said at least two sets based on the active content selection, as required by claim 15. As such, and based on the foregoing, claims 9 and 15 are clearly patentable. Because claims 10 and 16 depend from claims 9 and 15, respectively, they are at least patentable by virtue of their dependency as well for their additional recitations. Accordingly, the immediate withdrawal of the rejection of claims 9, 10, 15 and 16 under section 103 over Price in view of Madduri is respectfully requested.

With regards to 5-7 and 21-25 being rejected under the combination of Price in view of Wilcox, Wilcox fails to provide what is lacking in Price and as applied to independent claim 21 and independent claim 23. And similarly for the reasons stated above with regards to Price, the combination of Price in view of Wilcox fails to render obvious claims 5-7 and 21-25. Specifically, Wilcox offers a very involved content-by-bitmap filtering system, however, the combination of Price and Wilcox fails to meet the Examiner's burden of *prima facie* obviousness over claims 5-7 and 21-25. Therefore, for at these reasons discussed above, Applicants respectfully submit that independent claims 21 and 23 are clearly patentable over the combination of Price in view of Wilcox. Because claims 5-7 and 22, 24-25 depend from independent claims 21 and 23 respectively, they are at least patentable by virtue of their dependency as well as for their additional recitations. Accordingly, Applicants request the immediate withdrawal of the rejection of claims 5-7 and 21-25 under section 103 over Price in view of Wilcox.

With regards to claim 2 and the rejection over the combination of Price, Wilcox in view of Schilit, Schilit fails to provide what is lacking to the combination of Price and Wilcox to render the subject matter of claim 2 obvious. Instead, for at least the reasons discussed above with regards to independent claim 23, and for the fact that Schilit merely describes a single document or a collection of individual documents all supported by a common word processing application, Schilit in combination with Price and Wilcox fails to render obvious Applicants claimed invention for at least the reasons discussed above, as such because claim 2 depends from independent claim 23, claim 2 is at least patentable by virtue of the dependency as well as the additional recitation supplied by claim 2. Accordingly, the immediate withdrawal of the

rejection of claim 2 under section 103 over Price and Wilcox in view of Schilit is respectfully requested.

With regards to claim 26 being rejected over Price and Wilcox in view of Madduri, Madduri fails to provide what is lacking over the combination of Price and Wilcox for at least the same reasons discussed above with regards to base independent claim 23. As such, claim 26 is clearly patentable because claim 26 depends from independent base claim 23 and is at least patentable by virtue of the dependency as well as for the additional recitation supplied by claim 26. Accordingly, the immediate withdrawal of the rejection of claim 26 over Price under section 103 over Price and Wilcox in view of Madduri is respectfully requested.

III. Conclusion

All matters having been addressed in view of the foregoing, Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicants' undersigned representative remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. If any point remains an issue in which the Examiner feels would be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

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Please charge any fees associated with the submission of this paper to Deposit Account No. 02-2448. The Commissioner for Patents is also authorized to credit any overpayments to the above-referenced deposit account.

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Respectfully submitted,

By

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